

## **REMARKS**

### **I. Restriction as to Inventions**

The Examiner has issued a restriction requirement stating that the application claims four separate inventions. Specifically, the Examiner identifies the four inventions as being:

Group I: Claims 1-31, drawn to a method for identifying multiple different transcription factors in a cell sample, classified in class 435, subclass 91.1.

Group II: Claims 32-39, drawn to a method for characterizing a cell type of a cell sample, classified in class 435, subclass 70.1.

Group III: Claims 39-42, drawn to a method for diagnosing a disease state in a cell sample, classified in class 424.

Group IV: Claims 43-46, drawn to a method for screening transcription factor modulators, classified in class 435, subclass 91.5.

Pursuant to 37 C.F.R. 1.142, Applicants elect Group I (Claims 1-31) without traverse and cancels without prejudice the claims of Groups II, III and IV (Claims 32-46).

### **II. Restriction as to Subgenus**

The Examiner has also required that upon selection of any of Groups I-IV, Applicants must further elect a specific subgeneric composition from numerous groups of genus. Applicants hereby elect without traverse the following subgenus:

1) within the genus of activated transcription factors, a subgenus of activated transcription factors listed in the table shown in Figure 2 under the column labeled as "Transcription Factor";

2) within the genus of cis elements, a subgenus of cis elements listed in the table shown in Figure 2 under the column labeled as "Cis-Element";

3) within the genus of a promoter sequence 3' to a cis element, a subgenus of the promoter disclosed in the Specification on page 17, lines 15-21; and

4) within the genus of reporter sequence 3' to a cis element, a subgenus of reporter sequence listed in the table shown in Figure 2 under the column labeled as "Reporter Sequence".

### **III. Election of Species**

The Examiner has also required Applicants to elect a single disclosed species for prosecution on the merits. Applicants hereby elect without traverse the following species:

- 1) at least 10 different cis elements (claim 2);
- 2) at least 2 copies of the cis element (claim 6);
- 3) cis element having a length of 5-100 base pairs (claim 9);
- 4) the variable sequence of the reporter sequence being at least 15 bases in length (claim 12);
- 5) Hela cell line as a species of the mammalian cell line (claim 18);
- 6) at least 10 different reporter sequences (claim 21);
- 7) 5' priming sequence, the whole or a part of which is included in or a complement of the reporter sequences listed Figure 2 under the column labeled as "Reporter Sequence" (claim 25);
- 8) 3' priming sequence, the whole or a part of which is included in or a complement of the reporter sequences listed Figure 2 under the column labeled as "Reporter Sequence" (claim 25);
- 9) a library of hybridization probes that hybridize to the reporter sequences listed Figure 2 under the column labeled as "Reporter Sequence" or to the complements thereof (claim 27);
- 10) a reporter protein that can be expressed by the cell as disclosed in the Specification on page 18, lines 22-26 (claim 29);
- 11) a library of antibodies that are selective for the expressed protein as disclosed in the Specification on page 14, lines 23-24 (claim 30); and
- 12) a diseased cell that is a human diseased cell such as a HeLa cell (new claim 50).

Accordingly, claims 3-8, 10-11 and 13-17 are withdrawn as being directed to the non-elected species pursuant to 37 C.F.R. §1.142(b). However, Applicants reserve the right pursuant to 37 C.F.R. §1.141 to pursue claims to the non-elected species or subgenus in this application in the event that a generic claim is found to be allowable.


Applicants also reserve the right pursuant to 35 U.S.C. §121 to file one or more divisional applications directed to the non-elected species or subgenus during the pendency of the present application.

### **CONCLUSION**

The Commissioner is authorized to charge any additional fees which may be required, including petition fees, or credit any overpayment to Deposit Account No. 23-2415 (Attorney Docket No. 26757-709).

WILSON SONSINI GOODRICH & ROSATI  
Respectfully submitted,

Date: Nov 20. 2003

By:   
Shirley Chen, Ph.D.  
Registration No. 44,608

650 Page Mill Road  
Palo Alto, CA 94304-1505  
(650) 565-3856  
**Client No. 021971**